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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,284	08/18/2003	Chandrasekhar Narayanaswami	YOR920030212US1	8157

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EXAMINER

SHAH, AMEE A

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/643,284

Applicant(s)

NARAYANASWAMI,
CHANDRASEKHAR

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 10-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7, 10-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 3-7, 10-14 and 16-20 are pending in this action.

Response to Amendment

Applicant's Amendment, filed October 9, 2006, has been entered. Claims 1, 2, 8, 9 and 15 have been cancelled. Claims 3, 6, 10, 13 and 19 have been amended. Claims 3-7, 10-14 and 16-20 remain pending. In view of the amendments to claim 10, the 35 U.S.C. §101 rejections are withdrawn.

The amendments to the specification, including the Abstract, are accepted and the objections to the specification are withdrawn.

Response to Arguments

Applicant's arguments filed October 9, 2006, have been fully considered but they are not persuasive. While many of the arguments are moot in view of the new ground(s) of rejection necessitated by the amendment, some of the arguments must still be addressed as they pertain to obviousness which still forms the ground(s) of rejection.

In response to applicant's argument regarding claims 2, 9, 15, 19 and 20, the subject matter of which has been incorporated into amended claims 3, 10, and 17, that the Examiner failed to properly establish a prima facie case of obviousness of the invention of a whole because there was no specific hint or suggestion in the art to combine the references (Remarks, page 11), specifically relying on *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), the Examiner responds that Applicant misinterprets both *Lee* and the definition of "art." In *Lee*, the

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Board affirmed the Examiner's rejection based on obviousness when no motivation to combine was provided (61 USPQ2d 1431-1432). The Court stated that the Examiner needed to provide motivation and that the board needs to be specific in that "when they [the Examiner and the Board] rely on what assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record ... [the Board] must set forth the rationale on which it relies." (61 USPQ2d 1434-1435.) Thus, the Court in *Lee* did not hold "that the Boards' rejection of a need for any specific hint or suggestion in the art to combine the references was both legal error and arbitrary agency action..." (Remarks, page 11), i.e. that the motivation to be combined in the specific prior art cited. In fact, the Court supported prior cases such as *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988), (61 USPQ2d 1433) which stand for the proposition that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so **found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The motivation to combine must be based in the general art of the invention, not the specific prior art cited. In this case, as stated in the prior office action and below, the motivation to combine the references is found in the knowledge generally available to one of ordinary skill in the art.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-7 and 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 10 recite the limitation "the second web site" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of this action only, the Examiner will interpret the limitation to refer to any second web site.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6-8, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrlich et al., US 2002/0111873 A1 (hereafter referred to as "Ehrlich") in view of Cansler et al., US 6,725,257 B1 (hereafter referred to as "Cansler").

Referring to claim 3. Ehrlich discloses a method on a web site for pricing a product and/or service, the method comprising:

- offering a product and/or service for sale on a first web site (Fig. 2 and ¶¶0058-0062 – note the first web site is the host merchant site);
- visiting a second web site (¶¶0062 and 0073 – note the second web site is the rival merchant's web site);
- selecting each of the plurality of products on the second web site (Fig. 3A and ¶¶0080, 0081 and 0086 – note that each product is selected on the second web site);
- reading from the second web site a price associated with each of the plurality of configurations (¶0074);
- calculating a price for each of the plurality of configurations of the product and/or service based on the prices determined from the second web site and at least one price factor (¶¶0076, 0077, 0083 and 0085 – note that the price factor is the threshold); and
- offering each of the plurality of configurations of the product and/or service for sale on the first web site for the calculated prices (¶¶0077, 0078, 0085 and 0088)
- wherein the at least one price factor includes any one of: the highest price that the market will bear for each of the plurality of configurations of the product and/or service on the first web site; and the lowest profitable price at which the first web site can sell each of the plurality of configurations of the product and/or service (¶¶0077, 0083 and 0084 – note that the

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factor is the highest price the market will bear is the minimum price reduction required to beat the rival merchant's price and the lowest profitable price is the minimum price threshold).

Ehrlich does not explicitly disclose wherein the product and/or service is available for purchase in a plurality of configurations. However, a product available for purchase is a plurality of configurations is similar to a plurality of products. For example, Cansler, in the same field of endeavor and/or pertaining to the same issue, discloses a method and system for configuring products wherein the product is available for purchase in a plurality of configurations (*see, at least*, Abstract). Once a configuration for a product is chosen, it is essentially a specific or customized product. Therefore, selecting, receiving and calculating prices for a plurality of products is equivalent to selecting, reading and calculating prices for a plurality of configurations.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ehrlich to include the teachings of Cansler to allow for the product and/or service to be available in a plurality of configurations to determine and calculate the price of the product in the desired configuration. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art that doing so would provide the user with the opportunity to customize the product exactly to his/her needs, thereby increasing customer satisfaction and the likelihood of a sale.

Referring to claim 6. Ehrlich in view of Cansler discloses the method of claim 3 wherein the product and/or service having a plurality of configurations is any one of: furniture, a computer, a car, and a boat (Cansler, col. 1, lines 22-24, col. 3, lines 32-34 and col. 9, lines 30-33

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– note the definition of vehicle inherently includes cars and boats). One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art that doing so would provide the user with the opportunity to customize products that typically have many configurations to his/her needs, thereby increasing customer satisfaction and the likelihood of a sale.

Referring to claim 7. Ehrlich in view of Cansler discloses the method of claim 6 wherein each of the first web site and the second web site are an e-commerce web site (Ehrlich, Figs. 1, 2 and ¶¶0058-0073).

Referring to claims 10, 13, 14, 16, 19 and 20. All of the limitations in apparatus claims 10, 13, 14, 16, 19 and 20 are closely parallel to the limitations of method claims 3, 6 and 7, analyzed above and are rejected on the same bases.

Claims 4, 5, 11, 12, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrlich in view of Cansler and further in view of Maritzen et al., US 2002/0052797 A1 (hereafter referred to as “Maritzen”).

Referring to claim 4. Ehrlich in view of Cansler discloses the method of claim 3 as discussed above, but does not disclose wherein the at least one price factor further includes information associated with a buyer of the product and/or service on the first web site. Maritzen in the same field of endeavor of electronic shopping, discloses a method and system for customizing prices of a product or service including wherein the customization is based on a

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price factor that includes information associated with a buyer of the product and/or service on the first web site (§0010 – note the information can be historical purchase activity or group to which user is a member).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ehrlich in view of Cansler to include the teachings of Maritzen to allow for price factor to include information associated with a buyer of the product and/or service on the first web site. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Maritzen that doing so would allow for the price to be set in a way that is likely to induce the customer to buy (Maritzen, §0009).

Referring to claim 5. Ehrlich in view of Cansler and further in view of Maritzen discloses the method of claim 4 wherein the information associated with the buyer of the product and/or service on the first web site includes any one of: the volume of the product and/or service that is being purchased by the buyer; the number of orders previously placed by the buyer on the first web site; the type of equipment owned by the buyer; and the classification of the buyer (Maritzen, §§0010 and 0039 – note the volume of product and number of orders included in purchase history, and is also the quantity of product to be purchased and the classification of buyer is the group membership). One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Maritzen that doing so would allow for the price to be set in a way that is likely to induce the customer to buy (Maritzen, §0009).

Referring to claims 11, 12, 17 and 18. All of the limitations in apparatus claims 11, 12, 17 and 18 are closely parallel to the limitations of method claims 4 and 5, analyzed above and are rejected on the same bases.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (1) Ehrlich et al., US 6,873,968 B2, which is the patent of the cited prior art Ehrlich. (2) Brown et al., US 2006/0265260 A1, discloses a system and method permitting a user to browse and compare a merchant's product using information about competitor prices including wherein requests are sent to a product database with competitor information (*see, e.g.*, Figs. 3-10B and pages 3-8).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

December 22, 2006



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